

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2131**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Received

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In re the Application of

James D. THORNTON et al.

Technology Center 2100
Group Art Unit: 2131

Application No.: 08/976,579

Examiner: C. Brown

Filed: November 24, 1997

Docket No.: JAO 34191

For: PAPER DOCUMENT SATCHELS

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed September 11, 2002, reconsideration of the above-identified application is respectfully requested. Claims 1-28 remain pending in this application.

The Office Action rejects claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over Kurokawa (U.S. Patent No. 4,811,111) in view of Zdybel (U.S. Patent No. 5,486,686). Applicants respectfully traverse the rejection.

In particular, Applicant asserts that neither Kurokawa or Zdybel, either alone or in combination, disclose or suggest a system for producing and processing a paper document, having at least a token generator that generates user-selectable tokens relating to at least one other document, the other document being an electronic document, for purposes of linking the other document, encoding the generated tokens and a selector that allows a user to select

one or more decoded tokens from a list of decoded tokens, a recited in independent claim 1, and similarly recited in independent claims 10, 19 and 28.

As admitted in the Office Action, Kurokawa does not disclose the use of tokens and, hence, does not disclose the use of a token generator, encoding tokens or printing encoded tokens. See Office Action, page 3, lines 3-5.

Zdybel discloses an electronic document processing system that permits a less error prone alternative to employing conventional recognition techniques for recovering digital data defining the recognizable features of human readable, hardcopy rendering of an electronic source document 32. See column 10, lines 1-5. Zdybel enables data which is potentially important to the accuracy and/or completeness of the *reconstruction of the electronic source document 32 to be recovered*, even if such data is not evident or inferable from the appearance of the human readable rendering of the source document. See column 10, lines 7-27.

As discussed in the Office Action, Zdybel can be utilized *for encoding information about the electronic representation of the document itself*, such as file name, creation and modification dates, access and security information, and printing histories. See column 4, line 64 - column 5, line 2

In stark contrast to Applicant's claimed invention, neither Kurokawa or Zdybel, disclose or suggest a system for producing and processing a paper document, having at least a token generator that generates user-selectable tokens relating to at least one other document, the other document being an electronic document, for purposes of linking the other document, encoding the generated tokens and a selector that allows a user to select one or more decoded tokens from a list of decoded tokens.

On the contrary, because Zdybel merely generates "glyphs" on a paper document related to the document itself, Zdybel does not generate user-selectable tokens relating to at

least one other document, the other document being an electronic document, for purposes of linking the other document. In fact, Zdybel is not even concerned with linking other documents with each other. Thus, a combination of the applied references would not have resulted in a paper document that includes tokens representing a list of other documents, references, services, programs, etc., that are all linked together by the paper document.

Accordingly, because Zdybel fails to compensate for the deficiencies in Kurokawa, Applicants assert that it would not have been obvious to combine the references to arrive at the Applicants' claimed invention. Thus, Applicants assert that independent claims 1, 10, 19 and 28 define patentable subject matter. Claims 2-9, 11-18 and 20-27 depend from claims 1, 10 and 19 and therefore also define patentable subject matter. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

In view of the above remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-28 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,



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